

Remarks

Claims 1-65 are pending in this application. Claims 1-54 stand rejected by the Examiner, and claims 55-65 have been withdrawn from consideration.

In the present Amendment, claims 1 and 2 are amended, and no new claims are added. Applicant submits that no new matter has been added by these amendments and that the amended claims are now in condition for allowance. Applicant reserves the right to pursue the subject matter canceled from this case in future applications claiming priority to the present application.

Each of the rejections levied in the outstanding Office Action is addressed individually below.

I. Rejection under 35 U.S.C. § 102(b) as being anticipated by Sternson *et al.*, *Organic Letters* 3(26):4239-4242, 2001.

Claims 1-54 have been rejected under 35 U.S.C. § 102(b), as being anticipated by Sternson *et al.* The Examiner maintains that the present application claims dioxane compounds that share the structure of those compounds disclosed in Sternson *et al.* Applicant respectfully points out that the present application claims priority to provisional patent application, U.S.S.N. 60/289,850 (“the ‘850 application”), filed May 9, 2001, as indicated in paragraph [0001] of the present application. As required § 119(e), the ‘850 application discloses dioxane compounds “in the manner provided by the first paragraph of section 112” (see pages 11-17, 19-25, 26-30, and Figure 5-13) and includes a subset of the inventors listed on the present application. The present application claims priority to the ‘850 application through U.S. patent application U.S.S.N. 10/144,316 (“the ‘316 application”), filed May 9, 2002, which was filed no later than a year after the filing date of the ‘850 application. The present application, therefore, properly claims priority to the ‘850 application and is entitled to the benefit of the filing date of May 9, 2001. This priority date is almost seven months before the first publication of the Sternson *et al.* article on the web (*i.e.*, November 30, 2001, as indicated in the lower left hand corner of the first page of the article). Therefore, Sternson *et al.* is not prior art under § 102 citable against the present application, and the Examiner’s rejections based on Sternson *et al.* must be removed.

Furthermore, the compounds claimed in the present Application are also disclosed in the non-provisional ‘316 application, filed May 9, 2002. See paragraph [0036]-[0075] of the ‘316

application. In case the Examiner does not find support for the claimed compounds in the '850 application, support for these compounds is found in the '316 application. The '316 application was filed less than one year after the publication of Sternson *et al.*; therefore, Sternson *et al.* is only available as prior art under § 102(a). In order to remove Sternson *et al.* as § 102(a) prior art, Applicant submits herewith a Declaration under 37 C.F.R. § 1.131 signed by Professor Stuart L. Schreiber stating that the claimed subject matter was not invented by another. All the authors of the Sternson *et al.* article are listed as inventors on the present Application. The '316 application was filed within the one year grace period of the first public disclosure. Therefore, Sternson *et al.* is not § 102(a) prior art citable against the present application since the subject matter disclosed in Sternson *et al.* was not invented by another. Therefore, even if the Examiner does not find support for the claimed compounds in the '850 application, a rejection under § 102(a) is also not proper.

II. Rejection under 35 U.S.C. § 102(b), as being anticipated by Kuruvilla *et al.*, Nature 416:653-657, 2002.

Claims 1-45 have also been rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Kuruvilla *et al.*. Again, the Examiner maintains that the present application claims dioxane compounds that share the same structure as those compounds disclosed in Kuruvilla *et al.* Although Kuruvilla *et al.* may disclose some of the compounds claimed in the present Application, the Kuruvilla *et al.* article was not published until 2002 after the priority date of the present application based on the filings of the '850 and '316 applications. Again, disclosure of dioxane compounds is shown on pages 11-17, 19-25, 26-30, and Figure 5-13 of the '850 application. Therefore Kuruvilla *et al.* is not prior art citable against the present application, and the Examiner's rejection is not proper. Applicant requests that the rejection be removed.

As discussed above, the compounds claimed in the present Application are also disclosed in the non-provisional '316 application, filed May 9, 2002. See paragraph [0036]-[0075] of the '316 application. The '316 application was filed less than one year after the publication of Kuruvilla *et al.*; therefore, Kuruvilla *et al.* is only available as prior art under § 102(a). However, for a reference to qualify as prior art under § 102(a), the disclosed subject matter must have been invented by another. In order to remove Kuruvilla *et al.* as a § 102(a) reference, Applicant

submits herewith a Declaration under 37 C.F.R. § 1.131 signed by Professor Stuart L. Schreiber stating that the claimed subject matter was not, in fact, invented by another. Only Schreiber and Sternson qualify as inventors of the claimed subject matter. Therefore, Kuruvilla *et al.* is not § 102(a) prior art citable against the present application since the subject matter disclosed in Kuruvilla *et al.* was not invented by another.

III. Rejection under 35 U.S.C. § 102(b), as being anticipated by Sternson *et al.*, *J. Am. Chem. Soc.* 123:1740-47, 2001.

Claims 1-54 have been rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Sternson *et al.*, *J. Am. Chem. Soc.* 123:1740-47, 2001. Again, the Examiner maintains that the present Application claims dioxane compounds that share the structure of those compounds disclosed in Sternson *et al.* Although Sternson *et al.* may disclose some of the compounds claimed in the present Application, the '850 application, which the present Application claims priority to, was filed within one year of the publication of Sternson *et al.* Therefore, Sternson *et al.* is only prior art under § 102(a). Sternson *et al.* is not prior art under § 102(b) given the fact that the claimed compounds were disclosed in the '850 application in the manner provided by the first paragraph of § 112 and the '850 application was filed within a year of the publication of Sternson *et al.*

In order to remove Sternson *et al.* as a prior art reference under § 102(a), Applicant submits herewith a Declaration under 37 C.F.R. § 1.131 signed by Professor Stuart L. Schreiber stating that the claimed subject matter was not invented by another. Only Sternson, Wong, and Schreiber qualify as inventors of the claimed subject matter. Therefore, Sternson *et al.* is not § 102(a) prior art citable against the present application since the subject matter disclosed in Sternson *et al.* was not invented by another.

III. Rejections under 35 U.S.C. § 103(a).

Claims 1-54 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over each of Sternson *et al.* (*Org. Lett.* 2001), Kuruvilla *et al.*, and Sternson *et al.* (*J. Am. Chem. Soc.* 2001). As discussed above, each of these three reference has been removed as prior art citable against the present Application either based on the priority date of the present


Application or based on the Declaration submitted herewith. Applicant respectfully requests that these rejections under § 103(a) also be removed.

IV. Conclusion

In view of the forgoing amendments and arguments, Applicant respectfully submits that the present case is now in condition for allowance. A Notice to that effect is requested.

Please charge any fees that may be required for the processing of this Response, or credit any overpayments, to our Deposit Account Number 03-1721.

Respectfully submitted,


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